

REMARKS

EXAMINER'S POSITION

The Examiner takes the position that the present application identifies three Groups of inventions identified as Group I encompassing claims 1 - 15 drawn to a process for activating a catalyst; Group II encompassing claims 16 - 18 drawn to a catalyst, and Group III encompassing claim 19 drawn to a process for hydrotreating a feed.

The Examiner cites PCT Rules 13.1 and 13.2 as support for her conclusions. In addition, the Examiner discusses the patentability of the present invention as it relates to United States Patent Number 4,272,401. As support for conclusions made by the Examiner, the Examiner mixes citations from the PCT and also citations from the MPEP.

APPLICANTS' POSITION

Applicants respectfully disagree with the Examiner, and Applicants take the position that the Examiner's Unity of Invention/Restriction Requirement is not correct with regards to Groups I-III.

The Examiner cites PCT Rules 13.1 and 13.2 throughout the restriction requirement documents. Applicants respectfully point out that the present application was filed designating the European Patent Office as the Receiving Office and International Searching Authority, and the International Searching Authority did not require restriction of the present claims as indicated by the Examiner. The present application is in Chapter II of the PCT phase application pending as a national application before the United States Patent and Trademark Office. Thus, the Examiner has cited 37 CFR 1.499 as support for requirement for restriction/Unity of Invention rejection under the PCT Rules.

37 CCR 1.499 states that if a national stage application lacks unity of invention under 37 CFR 1.475, the Examiner may issue a restriction requirement. 37 CFR 1.475(b)(3) states:

"An international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories: ... (3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product..."

As noted in MPEP 1893.03(d),


"A process is "specially adapted" for the manufacture of a product if the claimed process inherently produces the claimed product with the technical relationship being present between the claimed process and the claimed product. The expression "specially adapted" does not imply that the product could not also be manufactured by a different process."

With regards to the present application, it includes claims directed at a method for manufacturing a catalyst, claims 1 - 15 (Group I by the Examiner); the catalyst made by such a process, claims 16 - 18 (Group II by the Examiner), and claims related to the use of the catalyst so made, claim 19 (Group III by the Examiner). In fact, claim 16 is a "product by process claim" directed at a catalyst "obtainable by the process according to any of claims 1-15". Further, claim 19 relates to a hydrotreating process wherein the catalyst according to claim 10 is used in the process. Thus, Applicants respectfully submit that under 37 CFR 1.475(b)(3), the present application satisfies the conditions of unity of invention because Groups I - III are directed at a product, i.e. the catalyst, a process specially adapted for making the catalyst, and the use of the catalyst.

However, in order to be complete, the applicant must elect a Group of inventions. Thus, Applicants elect Group I, with traverse, preserving all rights to petition, etc.

Based on the preceding remarks, the Examiner is requested to reconsider and withdraw the restriction requirement/Unity of Invention rejection, and allow this application to proceed with Groups I - III in a single application. The Examiner is encouraged to contact Applicants' attorney should the Examiner wish to discuss this application further.

Respectfully submitted,



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